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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 15

Application Number: 09/391,462
Filing Date: September 08, 1999
Appellant(s): GOSSWEILER ET AL.

Joseph M. Young
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 21, 2002.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

Claims 1 – 9 are finally rejected. Claim 9 has been withdrawn from appeal by appellant; the final rejection of claim 9 is maintained.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1 - 8 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,342,830	WANT et al.	1-2002
6,249,212	BEIGEL et al.	6-2001

5,847,709	CARD et al.	12-1998
6,222,557	PULLEY et al.	4-2001

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 2, and 4 – 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Want et al., U.S. Patent No. 6,342,830 in view of Pulley et al., U.S. Patent No. 6,222,557.

As to claim 1, Want et al. teach a system for digital services comprising an electronic tag having a digitally readable identifier (col. 1, lines 66 – 67), an electronic tag reader configured to read the identifier of the electronic tag (col. 1, line 67 – col. 2, line 1), and a computing system connected to the electronic tag reader to provide digital services (col. 2, lines 2 – 5.) However, Want et al. does not teach that the system may be used to navigate N-space data sets.

Pulley et al. teach a method for navigating a three-dimensional data set (col. 2, line 66 – col. 3, line 3), with the computing system generating at least one transitional point in N-space for output between a currently displayed start point and a target point referenced by the user (col. 1, line 64 – col. 2, line 2.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Pulley et al. with Want et al. because Pulley et al.'s navigation of three-dimensional data sets would enable the method of Want et al. to provide an

intuitive and flexible method for navigating an N-space data set (Want et al., col. 1, lines 59 – 64.)

As to claim 2, Pulley et al. teaches that the data set is a graphical data set (col. 3, lines 4 – 13.)

As to claim 4, the combination of Want et al. and Pulley et al. teach the invention substantially as claimed with respect to claim 1. However, the combination of Want et al. and Pulley et al. does not teach that the electronic tag is premarked.

Want et al. teaches that tags may be placed on objects such as a sheet or a card (col. 2, lines 11 – 12.) One of ordinary skill in the art would have been able to infer that cards, such as credit cards, are premarked. Credit cards, for example, have the owner's name and card number stamped on them.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Want et al. in view of Pulley et al. to make Want et al.'s generic card a credit card premarked with the owner's name and card number because premarking the tags would allow a user to easily identify the meaning or purpose of a tag without needing to use the tag reader.

As to claim 5, the combination of Want et al. and Pulley et al. teach the invention substantially as claimed with respect to claim 1. However, the combination of Want et al. and Pulley et al. does not teach that the electronic tag presents a surface for user defined annotation.

Want et al. teaches that tags may be placed on objects such as a sheet or a card (col. 2, lines 11 – 12.) One of ordinary skill in the art would have been able to infer that cards, such as credit cards, may present surfaces for user defined annotation. Credit cards, for example, provide a surface where the card holder may sign the card.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Want et al. in view of Pulley et al. to make Want et al.'s generic card a credit card with a surface for the card holder's signature because providing a surface for user annotation would enable a user to mark the tag with any information the user may find useful.

As to claim 6, Want et al. teaches that the electronic tag is read by the tag reader through a wireless connection (col. 7, lines 38 – 41.)

As to claim 7, Want et al. teaches that the wireless connection operates at radio frequencies (col. 7, lines 38 – 41.)

As to claim 8, Want et al. teaches that the wireless connection is infrared (col. 7, line 45.)

Claims 1 and 3 – 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beigel et al., U.S. Patent No. 6,249,212, in view of Card et al., U.S. Patent No. 5,847,709.

As to claim 1, Beigel et al. teaches a system comprising an electronic tag having a digitally readable identifier and an electronic tag reader configured to read the identifier of the electronic tag (col. 2, lines 53 – 58.) However, Beigel et al. does not teach a computing system connected to the tag reader.

Card et al. teaches a computing system providing digital navigation services of N-space data (col. 3, lines 2 – 5) with the computing system generating at least one transitional data point in N-space for output between a currently displayed start point and a target point referenced by the identifier (col. 9, lines 37 – 40.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Card et al. with Beigel et al. because Card et al.'s digital navigation services would enable a user of Beigel et al.'s system to easily interact with and navigate through large N-space data sets (Card et al., col. 2, lines 66 – 67.)

As to claim 3, Card et al. teaches that the data set is a document data set (col. 2, lines 66 – 67.)

As to claim 4, the combination of Beigel et al. and Card et al. teach the invention substantially as claimed with respect to claim 1. However, the combination of Beigel et al. and Card et al. does not teach that the electronic tag is premarked.

Beigel et al. teaches that tags may be placed on objects (col. 1, lines 5 – 10.) One of ordinary skill in the art would have been able to infer that objects, such as credit cards, are premarked. Credit cards, for example, have the owner's name and card number stamped on them.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Beigel et al. in view of Card et al. to make Beigel et al.'s generic object a credit card premarked with the owner's name and card number because premarking the tags would allow a user to easily identify the meaning or purpose of a tag without needing to use the tag reader.

As to claim 5, the combination of Beigel et al. and Card et al. teach the invention substantially as claimed with respect to claim 1. However, the combination of Beigel et al. and Card et al. does not teach that the electronic tag presents a surface for user defined annotation.

Beigel et al. teaches that tags may be placed on objects (col. 1, lines 5 – 10.) One of ordinary skill in the art would have been able to infer that objects, such as credit cards, may present surfaces for user defined annotation. Credit cards, for example, provide a surface where the card holder may sign the card.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Beigel et al. in view of Card et al. to make Beigel et al.'s generic object a credit card with a surface for the card holder's signature because providing a surface for user annotation would enable a user to mark the tag with any information the user may find useful.

As to claim 6, Beigel et al. teaches that the tag is read by the tag reader through a wireless connection (col. 6, lines 1 – 8.)

As to claim 7, Beigel et al. teaches that the wireless connection operates at radio frequencies (col. 6, lines 1 – 8.)

As to claim 8, Beigel et al. teaches that the wireless connection is infrared (col. 1, lines 5 – 8.)

(11) Response to Argument

Appellant alleges that "the Examiner has provided no reason" why a person of ordinary skill in the art would have been motivated to combine the Want (U.S. Patent No. 6,342,830) and Pulley (U.S. Patent No. 6,222,557) references (brief at p. 9.)

In response, the Examiner notes that the appellant appears to have answered his own question: "To create an intuitive and flexible method for navigating a flexible N-space." (brief at p. 9.) More specifically, Want teaches that the tag may instruct the computer to perform a computer-controlled action (Want, col. 3, lines 56 – 57) "without requiring...complex input commands" (Want, col. 4, lines 9 – 10.) Want expressly teaches that the advantages of the tag is that it allows the user to perform complex input commands easily. Pulley teaches that "a user can reposition the viewpoint from which the image on [the] display is rendered, via...any...input device. Further, the user can augment constrains and/or positions provided within the predefined data landscape via input devices" (Pulley, col. 6, lines 12 – 16.) Pulley calls for an input device. Want discloses an input device that enables easy input of complex commands. One of ordinary skill in the art would be motivated to combine the two because Want's tag is easier to use than the input devices suggested by Pulley.

Appellant alleges that the tag "would probably add to the expense" of the Pulley patent (brief at p. 11.)

In response, the fact that a combination would not be made for economic reasons does not mean that a person of ordinary skill in the art would not make the combination. MPEP §2145 (VII), *In re Farrenkopf*, 713 F.2d 714, 219 USPQ 1 (Fed. Cir. 1983).

Appellant alleges that "the Examiner may be of the position that the invention claimed...would be obvious to try" (brief at p. 11.)

This allegation is irrelevant as the Examiner has never maintained such a position.

Appellant alleges that "the Examiner has not pointed to a relevant portion of the [Want] patent suggesting navigation of graphical data" (emphasis original)(brief at p. 12.)

In response, the appellant claims to recognize that appellant cannot attack references individually where the rejections are based on combinations of references (brief at p. 20.) However, this is exactly what the appellant is doing here. The Examiner is not relying on the Want patent to teach navigation of graphical data.

Appellant alleges that "the Examiner has...provided no suggestion or motivation as to why one skilled in the art would wish to combine [the Want and Pulley references] with the details of a credit card" (brief at p. 13.)

In response, the user-defined surface of a credit card provides obvious advantages: it enables a user to identify the tag as his or her own and acts as a security measure. A person of ordinary skill in the art would have been motivated to combine the user-defined surface of the

credit card with the Want and Pulley combination to enable user identification of the cards and to increase security and reduce the likelihood of misuse.

Appellant alleges that "the Examiner has not pointed to a relevant portion of the [Beigel] patent suggesting navigation of document data" (emphasis original)(brief at p. 12.)

In response, the appellant claims to recognize that appellant cannot attack references individually where the rejections are based on combinations of references (brief at p. 20.) However, this is exactly what the appellant is doing here. The Examiner is not relying on the Beigel patent to teach navigation of document data.

Appellant alleges that "the Examiner has...provided no suggestion or motivation as to why one skilled in the art would wish to combine [the Card and Beigel references] with the details of a credit card" (brief at p. 13.)

In response, the user-defined surface of a credit card provides obvious advantages: it enables a user to identify the tag as his or her own and acts as a security measure. A person of ordinary skill in the art would have been motivated to combine the user-defined surface of the credit card with the Card and Beigel combination to enable user identification of the cards and to increase security and reduce the likelihood of misuse.

Appellant alleges that the tag "would probably add to the expense" of the Card patent (brief at p. 17.)

In response, the fact that a combination would not be made for economic reasons does not mean that a person of ordinary skill in the art would not make the combination. MPEP §2145 (VII), *In re Farrenkopf*, 713 F.2d 714, 219 USPQ 1 (Fed. Cir. 1983.)

Appellant alleges that "the Examiner may be of the position that the invention claimed...would be obvious to try" (brief at p. 17.)

This allegation is irrelevant as the Examiner has never maintained such a position.

Appellant alleges that "the Examiner has prpointed to nothing in either the [Beigel] patent, the [Card] patent or the prior art in general that suggests that the...[Beigel] patent should be combined with the...[Card] patent" (brief at p. 15.)

In response, it would have been obvious to combine the Card and Beigel patents for at least similar reasons as given above with respect to the Want and Pulley references. Beigel also teaches tags that can be used for multiple purposes and with multiple readers (Beigel, col. 2, lines 53 – 54.) Thus it would have been obvious to one of ordinary skill in the art to combine the Card and Beigel references because Beigel's tag promotes interoperability.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Gregory Clinton
November 20, 2002

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